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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/721,518	11/25/2003	Koji Yamaya	17280	5316
23389 7590 09/12/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
KASZTEJNA, MATTHEW JOHN				
ART UNIT		PAPER NUMBER		
3739				
MAIL DATE		DELIVERY MODE		
09/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/721,518

Applicant(s)

YAMAYA ET AL.

Examiner

MATTHEW J. KASZTEJNA

Art Unit

3739

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6, 7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Claims 11-13 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2008.

Applicant's election without traverse of Group I, claims 6-7 and 9-10, in the reply filed on August 11, 2008 is acknowledged.

Notice of Amendment

In response to the amendments filed on May 13, 2008, amended claims 6-7 and 9-10 are acknowledged. The following new and reiterated grounds of rejection are set forth.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The amendments to independent claim 7 state that the first and second treatment tools are projected from the distal end of the insertion portion via first and second channels, respectively, at a "predetermined projecting length".

Applicant states that such amendments are supported by Figure 24 and the accompanying text of the specification. However, the examiner is unclear where in the specification a "predetermined projecting length" is disclosed. At most, the oscillating range of the treatment tool is said to be set depending on the length L of the stand-up bar (as disclosed in paragraph 0279). This is understood to mean the *angle* at which the tool is projected out from the distal end of the insertion portion, not the *length* which the tool is inserted out of the channel. Thus it is clear that the angle of projection may be set and predetermined by a user, not that the projecting length is predetermined. Furthermore, it is understood that the treatment tools are inserted through first and second channels and guided to approach an object via the oscillating bases. However, there is no disclosure as to how far the tool may be inserted therethrough or of on any limit as to how far the tools may be inserted, other than the overall length of the treatment tools. Thus, it is unclear what is meant with regard to the limitation of a "predetermined projecting length" for both the first and second treatment tools.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 6-7 and 9 are rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent No. 6,352,503 to Matsui et al.

In regards to claim 7, Matsui et al. disclose an endoscope apparatus 101 comprising: an insertion portion 102 having first 141 and second 143 channels arranged therein and terminating at first and second openings, respectively, at a distal portion of the insertion portion; an observation optical system for capturing an observation image, which is arranged to the insertion portion (see Col. 11, Lines 57-59); a first treatment-tool oscillating base (not labeled) which guides, in a first direction, a first treatment-tool 145 inserted via the first channel 141 arranged to the insertion portion, a range of oscillation of the first treatment-tool by the first treatment-tool oscillating base being set so as to cause a distal end of the first treatment-tool to be selectively positioned inside or outside the observation image, at a predetermined projecting length for the first treatment-tool to approach an object on the observation image (see Figs. 23 and 29 and Col. 14, Lines 28-34); and a second treatment-tool oscillating base (not labeled) which guides, in a second direction, a second treatment-tool 147 inserted via the second channel arranged in the insertion portion, a range of oscillation of the second treatment-tool by the second treatment-tool oscillating base being set so as cause a distal end of the second treatment-tool to be positioned inside the observation image, at a projecting length of the second treatment-tool which is *approximately* the same as the predetermined length of the first treatment-tool (see Fig. 29 and Col. 14, Lines 10-26).

In regards to claim 6, Matsui et al. disclose an endoscope apparatus, wherein the outside of the field of view is one in the top direction of the screen of the endoscope image (see Figs 1, 12 and 29 and Col. 14, Lines 10-67).

In regards to claim 9, Matsui et al. disclose an endoscope apparatus, wherein the first and second treatment-tool oscillating bases (not labeled, similar to raising base 127 in Figure 23) are rotatably provided in respective openings of the first 141 and second 143 channels, respectively (see Col. 12, Lines 32-40).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,352,503 to Matsui et al. in view of U.S. Patent Application Publication No. 2003/0163029 to Sonnenschein et al.

In regards to claim 10, Matsui et al. disclose an endoscope apparatus 101 comprising: an insertion portion 102 having first 141 and second 143 channels; an observation optical system and first 145 and second 147 treatment tools (see rejection above) but are silent with respect to a screen size in the guiding direction of the treatment tool guided to the outside of the field of view from the inside is set to have a shorter side, or to be shorter, as compared with a screen size in the guiding direction of the treatment tool guided within the inside range of the field of view and wherein the screen size has a length in the horizontal direction longer than that in the vertical direction. Sonnenschein et al. teach of an analogous endoscopic apparatus wherein

the field of view for the topical channel may be non-circular, such as square, rectangular, cylindrical, toroidal section or any other shape. The views may take on any shape and do not need to be of equal size (see Fig. 3c and paragraph 0075). It would have been obvious to one skilled in the art to vary the field of view with respect to the treatment tools of Matsui et al. to provide adequate visualization and alternate view fields of the tools used with the endoscope as taught by Sonnenschein et al.

Response to Arguments

Applicant's arguments filed May 13, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Matsui does not teach or suggest that the distal end of one of the treatment tools is guided outside the field of view, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant states that Matsui does not teach or suggest that the distal end of one of the treatment tools is guided outside the field of view. Examiner disagrees. Matsui teaches that the respective forceps raising mechanism raises the insertion section of the treating tool by bending the insertion section of the treating tool outwardly in a direction substantially *perpendicular* to the axial direction of an insertion section 102 of the endoscope 101 (see Col. 14, Lines 18-27). The treatment tool is guided in a perpendicular direction away from the central axis and thus also the field of view of

optical system. The further the treatment tool is inserted through the working channel, the further the distal end of the treatment tool will extend perpendicularly away from the field of view of the optical system. Thus, if the tool is inserted far enough into the body, the distal end of the tool will inherently be moved to outside the field of view. Therefore, the distal end of the treatment tool shown in the apparatus of Matsui is fully capable of being guided outside the field of view. As broadly as claimed, Matsui et al. meet the limitations of the recited claims.

In regard to the newly added limitations of claim 7, as seen in Figure 23, Matsui clearly shows first 106 and second 107 treatment tools projected from the distal end 109 of the insertion portion 102 at a length which is approximately equal. Furthermore, the projecting lengths of each of the instruments shown in Figs 25-29 are *approximately* equal.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./
Examiner, Art Unit 3739

9/8/8